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CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT 1713	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/798,183
Filing Date: March 11, 2004
Appellant(s): CORNELIUS MARIA DEKKERS ET AL.

MAILED
APR 30 2007
GROUP 1700

Karen A. LeCuyer
(Registration No. 51,928)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 3, 2007 appealing from the Office action mailed July 28, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 2, 4-19 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/797975. Although the conflicting claims are not identical, they are not patentably distinct from each other because the process invention of claims 1-20 of copending Application No. 10/797975 fully encompasses the invention of claims 1, 2, 4-19 of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Appellant's arguments filed March 30, 2006 and July 6, 2006 have been fully considered but they are not persuasive. The instant provisional ODP is maintained until a terminal disclaimer is filed.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1, 2, 4-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Podszun et al. (US 6,365,066).

Podszun et al. (abstract) disclose an antifouling coating composition. Further, Podszun et al. (col. 6, line 64 to col. 8, line 6) disclose various binder resins for making encapsulated particles. And Podszun et al. (col. 8, line 7-27) disclose the encapsulated particles comprises a list metal-containing zeolites, which includes silver, copper, etc. Podszun et al. (col. 8, line 20-23) disclose a list metal salts as well for the disclosed composition. Regarding film thickness, Podszun et al. (col. 9, line 20-53) disclose a film thickness of 150 micron or less after drying. Therefore, in view of substantially identical composition of the film and film thickness as disclosed in Podszun et al. and as claimed, the examiner has a reasonable basis to believe that the claimed biocidal metal release property, the exterior surface properties and texture properties, the biocidal activity, and the growth reduction as described in claim 19 are inherently possessed in Podszun et al. Since the PTO does not have proper means to conduct experiments, the burden of proof is now shifted to appellants to show otherwise. In re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977); In re Fitzgerald, 205 USPQ 594 (CCPA 1980).

(10) Response to Argument

Appellant's arguments filed January 3, 2007 have been fully considered but they are not persuasive.

In appellants' argument, appellants, as their own lexicographers, draw the distinction between the recited "textured" and the argued term "rough" or "non-textured" surfaces is that the recited "textured" is achieved through "mechanical" or "chemical" abrading means. However, appellants fail to recognize that the argued "mechanical" and "chemical" means does not necessarily impart the surface properties, such as nature of the surface, the surface area of the surface, or the porosity of the surface of the claimed article. Without a clear description on what it means by "textured" in appellants' specification, the examiner has a reasonable basis to define the recited "textured" as broad as possible to mean any "non-smooth" or "rough" surfaces, such as the surface properties as disclosed in Podszun et al.

The examiner acknowledges appellants' argument that claim 18 clearly does contain the argued feature "mechanical and chemical" means. However, such argument does not impact the patentability of claim 18 and other claims in view of the reasons set forth above, because the argued "mechanical" or "chemical" abrading means do not necessarily impart any unique surface property feature onto the claimed article. Therefore, the 102/103 rejection set forth is proper.

Regarding appellants' argument that "textured" surface is provided by calendaring rolls wherein the top roll and optionally the bottom roll comprise surface discontinuities or protrusion (specification, page 88), and that the protrusions have a length of about 200 nanometers to about 20 micrometers... Since Podszun et al. are silent on surface discontinuities or protrusions as claimed, appellants believe that 102/103 rejection set forth should be withdrawn. However, appellants fail to recognize that the claims as written fail to recite the argued features "protrusions having a length of about 200 nanometers to about 20 micrometers". Therefore, the examiner has a reasonable basis that the argued "protrusions" features are not supported by the claims. Appellants must recognize that the claims are read in light of the specification. However, the specification can not be read into the claims.

Regarding appellants argue that it is unclear why the examiner stated that Podszun et al. "clearly indicates that the active substances are visible to the naked eyes" in the office action of July 28, 2006, appellants fail to recognize that "roughness" on the coating on Podszun et al. is characterized by having the active substances (biocidal agents) exposed to the extent that active substances are visible to the naked eyes. With the active substances exposed, it would not be difficult for one of ordinary skill in art to recognize that the increase in exposed area would means the increase of biocidal properties as claimed.

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Appellants also argue that the use of "doctor blade" for making a homogeneous coating would lead to a smooth coating (not texture), the examiner disagrees because there is no evidence to show that the use of "doctor blade" would automatically give a smooth coating. Typically, a "doctor blade" is used to maintain the homogeneity of the thickness of a coating, and the use of "doctor blade" does not automatically generate a smooth surface, especially when Podszun et al. (col. 9, line 67) have already indicated a "rough" surface.

Regarding appellants' argument that the claimed article is characterized by a biocidal metal release rate while the prior art Podszun et al. is drawn to an anti-fouling coating with the preference of not releasing any biocidal metal, the examiner disagrees because appellants fail to recognize that both coating composition as claimed and as disclosed in Podszun et al. do involve the release of biocidal metal and the rate of biocidal release properties in order to possess the biocidal properties on the coating of Podszun et al. or the article as claimed. Further, appellants do not have any evidence to show that the articles of Podszun et al. do not involve the release of inorganic biocidal agent.

Regarding appellants' argument that the examiner fails to provide a motivation from Podszun et al. to obtain the improved biocidal properties as claimed, appellants fail to recognize that under 102/103 rejection set forth, in view of the substantially identical article disclosed in Podszun et al. and the article as claimed, the examiner has a

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reasonable basis to request comparative data to show that article in Podszun et al. do not possess the improved biocidal properties as claimed.

Regarding appellants' argument that the examiner fails to consider the comparative data in the specification, the examiner disagrees because the examiner has considered the comparative data in the specification. However, examiner has found that the comparative data are inadequate in overcoming the rejection set forth because exposing the active ingredient (col. 9, line 65-66) as disclosed in Podszun et al. clearly inherently possess an improvement in the biocidal properties as claimed, without the need of any additional special processing step.

Regarding appellants' argument on "unexpected" results, in order to show the criticality of the claimed "textured" feature, appellants are required to submit comparative data of the samples as claimed and the samples prepared according to the procedure set forth in the prior art, Podszun et al. Since appellants do not have any data that are done according to the procedure of Podszun et al., appellants fail to show the criticality of the claimed "textured" feature as claimed.

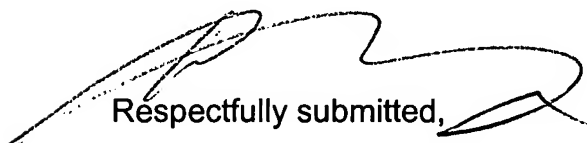
In view of the reasons set forth above, the examiner maintains that the rejection set forth is proper.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

William K. Cheung, Ph. D.

Primary Examiner


**WILLIAM K. CHEUNG
PRIMARY EXAMINER**

April 23, 2007

Conferees:



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